REMARKS

Claims 1 and 3-10 are pending in this application. Claim 2 has been canceled.

Rejections under 35 U.S.C. §§102/103

Claims 1-9 have been rejected under 35 U.S.C. §§102/103 as being anticipated by or obvious over EP 0 887 701 (hereinafter referred to as "EP '701"). More specifically, the Examiner interprets EP '701 as teaching a thermally processed image forming material containing a fatty acid silver salt. The Examiner asserts that the material of EP '701 contains the same fatty acid, made by the same process or an obvious process as that recited in the present claims. Applicants traverse this rejection and withdrawal thereof is respectfully requested.

The present invention, as encompassed by claim 1, is drawn to a thermally processed image forming material containing elsewhere on a support a reducing agent, a binder and non-photosensitive fatty silver salt grains that are prepared by mixing and reacting a silver ion-containing solution, the solvent of which being water or a mixture of water and an organic solvent, with a solution of a fatty acid alkali metal salt, the solvent of which being water, an organic solvent, or a mixture of water and an organic solvent, in a closed mixing means.

EP '701 is silent with regard to a closed mixing means for preparing non-photosensitive fatty acid silver grains. As such, the present invention is not anticipated by EP '701.

The invention is further not obvious over the disclosure of EP '701. For the Examiner to establish that the claimed invention is *prima facie* obvious, there must be some suggestion of the claimed invention in reference relied on by the Examiner. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon 733 F. 2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The Examiner has failed to provide any motivation for using a closed mixing means to prepare the non-photosensitive fatty acid silver grains. As such, the Examiner has failed to adequately support a rejection of the claims as being *prima facie* obvious.

Assuming *arguendo* that the invention could be deemed *prima facie* obvious over the disclosure of EP '701, the compositions of the present invention have unexpected, advantageous properties due to the process by which they are made compared to the materials of EP '701. As shown in Tables 1-3 of the specification, materials of the present invention using Dispersions B through H have improved properties, such as a low Dmin and high black density and superior coated surface properties compared to the materials of the

prior art made with Dispersion A. As such, the present invention is not obvious over EP '701.

The invention of claims 4 and 10 contain further features that are not disclosed or suggested in EP '701 with regard to the nucleating agents.

Claim 10 has been rejected as being obvious over EP '701 combined with WO 97/34196 (WO '196). The WO '196 reference is relied on for generally teaching the inclusion of nucleating agents. WO '196 further fails to teach or suggest the preparation of non-photosensitive fatty acid silver grains using a closed mixing means. As such, WO '196 fails to make up for the deficiencies of EP '701 and the invention of claim 10 is not achieved by combining the references.

As the above-indicated amendments and remarks address and overcome the rejection of the claims, withdrawal of the rejections and allowance of the claims are respectfully requested. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact MaryAnne Armstrong, PhD (Reg. No. 40,069) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a two (2) month extension of time for filing a reply in connection with the present application, and the required fee of $400.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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MSW/MAA/csp
2870-0137P

Attachment: Version with Marking to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 2 has been cancelled.

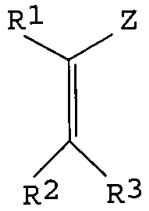
Claims 1, and 3-5 have been amended as follows.

1. (Amended) A thermally processed image forming material containing elsewhere on a support a reducing agent, a binder and non-photosensitive fatty silver salt grains characterized in that ~~(1)~~ the non-photosensitive fatty acid silver salt grains are prepared by mixing and reacting a silver ion-containing solution, the solvent of which being water or a mixture of water and an organic solvent, with a solution of a fatty acid alkali metal salt, the solvent of which being water, an organic solvent, or a mixture of water and an organic solvent, in a closed mixing means~~, or (2) the non-photosensitive fatty acid silver salt grains are prepared by micro-dispersing the reaction mixture at an operating pressure of 1,800 kg/cm^2 or above using a ultrahigh pressure dispersion apparatus~~.

3. (Amended) The thermally processed image forming material as claimed in Claim ~~2~~ 1, wherein the non-photosensitive fatty silver salt grains are prepared by cooling a reaction mixture

obtained after the reaction proceeded within the closed mixing means.

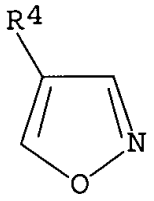
4. (Amended) ~~The~~ A thermally processed image forming material containing elsewhere on a support a reducing agent, a binder and



non-photosensitive fatty silver salt grains characterized in that the non-photosensitive fatty acid silver salt grains are prepared by micro-dispersing the reaction mixture at an operating pressure of 1,800 kg/cm^2 or above using a ultrahigh pressure dispersion apparatus, the nucleation aid being at least any one of a compound selected from the group consisting of a substituted alkene derivative expressed by the general formula (1) below, a substituted isooxazole derivative expressed by the general formula (2) below, and an acetal derivative expressed by the general formula (3) below:

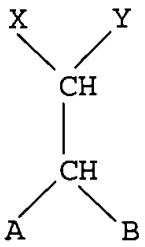
(1)

(where, R^1, R^2 and R^3 independently represent a hydrogen atom or substituent; Z represents an electron attracting group or silyl group; and, R^1 and Z, R^2 and R^3, R^1 and R^2, or R^3 and Z may individually bind with each other to form a cyclic structure),



(2)

(where, R^4 represents a substituent), and



(3)

(where, X and Y independently represent a hydrogen atom or substituent; A and B independently represent alkoxy group, alkylthio group, alkylamino group, aryloxy group, arylthio group, anilino group, heterocyclic oxy group, heterocyclic thio group or heterocyclic amino group; and, X and Y, or A and B may individually bind with each other to form a cyclic structure) ~~as claimed in Claim 1, wherein the non photosensitive fatty silver salt grains are prepared by the process (2)~~.

5. (Amended) ~~The~~ A thermally processed image forming material containing elsewhere on a support a reducing agent, a binder and non-photosensitive fatty acid silver salt grains characterized in that the non-photosensitive fatty acid silver salt

grains are prepared by (1) mixing and reacting a silver ion-containing solution, the solvent of which being water or a mixture of water and an organic solvent, with a solution of a fatty acid alkali metal salt, the solvent of which being water, an organic solvent, or a mixture of water and an organic solvent, in a closed mixing means, and then (2) micro-dispersing the reaction mixture at an operating pressure of 1,800 kg/cm^2 or above using a ultrahigh pressure dispersion apparatus ~~as claimed in Claim 4, wherein the non-photosensitive fatty silver salt grains are prepared by the process (1) followed by the process (2)~~.